

### **REMARKS**

Applicant has amended claim 1. Claims 7-8 and 21 have been withdrawn from consideration. Claims 1-3 are currently pending. Applicant requests further consideration and examination in view of the following remarks.

#### **Election/Restriction**

The Examiner states that there is no record of Applicant canceling claims 4-6, 9-19 and 22-23. Applicant would again refer the Examiner to the Preliminary Amendment filed March 31, 2004. Applicant has consulted Public PAIR and confirmed that the on page 1, last paragraph, Applicant asked that claims 4-6, 9-19 and 22-23 be canceled. The Examiner is invited to call the undersigned attorney if upon further review, the Examiner cannot find record of the cancellation of claims.

#### **Drawings**

The Examiner has asserted that the limitation reciting a “second valve seat” is not shown in the drawings. Applicant respectfully disagrees. Applicant would refer the Examiner to element 98 shown in Figure 12 and to page 12, line 29 which describes “second valve seat 98”. Applicant submits that the drawings are complete as shown and requests that the Examiner withdraw the objection to the drawings.

#### **Rejection under 35 U.S.C. § 102**

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,946,448 as to Richmond (hereinafter “Richmond”).

It is well settled that to anticipate a claim, the reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he elements must be arranged as required by the claim,” see M.P.E.P. § 2131, citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim,” see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9

U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that the rejection does not satisfy these requirements.

Claim 1 requires first portions of the housing defining a first valve seat around the injection lumen, second portions of the housing defining a second valve seat around the injection lumen, a valve element disposed to extend transverse to the injection lumen, the valve element forming a first seal with the first valve seat in response to a first pressure, the valve element forming a second seal with the second valve seat in response to a second pressure greater than the first pressure of the fluid in the flow channel, and the valve element forming an open configuration between said lumen and said flow channel in response to a third pressure in said lumen greater than one of said first pressure and said second pressure. Richmond does not describe these limitations.

Richmond describes a check valve 12 that includes disk 84 which includes valve seat 78. Figures 2 and 3, column 42-45. In the circumstance where the pressure downstream from the disc is higher than the upstream pressure, valve disc 84 is pressed against valve seat 78 preventing fluid flow through the check valve. Nowhere does Richmond describe a second valve seat with which the valve element can form a second seal, as required by claim 1.

As claim 1 includes limitations that are not described in Richmond, Applicant respectfully asserts claim 1 is allowable over the rejection of record. Claims 2 and 3 depend directly from claim 1 and are therefore allowable for at least the reasons set forth with respect to claim 1.

The Examiner has stated that certain limitations in claim 1 were not entitled to be read as distinguishing limitations over the prior art. Applicant respectfully disagrees with the Examiner's characterizations of those limitation, however, in the interest of furthering prosecution, Applicant has amended claim 1 to make clear that those limitations were structural limitations to the claim. Claim 1 was amended for this purpose only and not in view of the prior art cited by the Examiner.

**Rejection on the grounds of Double Patenting**

Claims 1-3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,364,861.

Claims 1-3 require that the valve element forming an open configuration between said lumen and said flow channel in response to a third pressure in said lumen greater than one of said first pressure and said second pressure. Applicant respectfully asserts that claims 1-25 does not describe the combination of limitations recited in claims 1-3, and in particular, a combination reciting the above identified limitation.

As such, Applicant believes that claims 1-3 are patentably distinct from the subject matter claimed in U.S. Patent No. 6,364,861 and not subject to a nonstatutory obviousness-type double patenting rejection. Applicant respectfully requests such rejection be withdrawn.

**CONCLUSION**

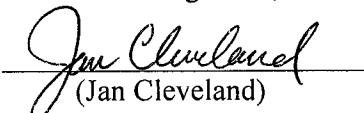
In view of the above, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 06-2380, under Order No. 74688/P004CP1D1/10804933 from which the undersigned is authorized to draw.

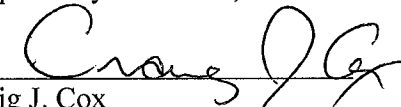
Dated: August 28, 2008

I hereby certify that this document is being transmitted to the Patent and Trademark Office via electronic filing.

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Signature:   
(Jan Cleveland)

Respectfully submitted,

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